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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO.       |
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| 09/611,165   | 07/06/2000  | John C. Calhoun JR.  | 5044:84                   | 5604                   |
| 7590 10/16/2008  |             |                      |                           |                        |
| Stanley R Moore Esq<br>Jenkins & Gilchrist PC<br>1445 Ross Avenue Suite 3200<br>Dallas, TX 75202 |             |                      | EXAMINER<br>FRENEL, VANEL |                        |
|  |             |                      | ART UNIT<br>3687          | PAPER NUMBER           |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/611,165

Applicant(s)

CALHOUN ET AL.

Examiner

VANEL FRENEL

Art Unit

3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date: 20081004
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/01/08 has been entered.

**Notice to Applicant**

2. This communication is in response to the RCE filed on 08/01/08. Claims 1, 12 and 13 have been amended. Claims 1-20 are pending.

**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warady et al (6,067,522) in view of Joao (7,305,347).

As per claim 1, Warady discloses the computer system comprising: a memory (See Warady, Col.7, lines 50-67), and a set of linked data tables organized into a logical entity in the memory and including for each member (See Warady, Fig.2; Col.5, lines 5-42): a master account table including account setup information for at least one of utilization and login actions for said web-based managed care transaction system, a member table including identity information for at least one member and their dependents (See Warady; Col.9, lines 24-58); a set of one or more member history tables associated with the member table, each member history table associated with a given employer plan, wherein said logical entity is persistent over changes to each members' changes within said employer plan (See Warady, Col.4, lines 1-67 to Col.5, line 64).

Warady does not explicitly disclose a computer system for use in a web-based managed care transaction system, "wherein the web-based managed care transaction system is adapted to enable via the linked set of data tables, an administrative account to be moved across health plans of the at least one member and their dependents throughout their life;

wherein the web-based managed care transaction system is adapted to allow the at least one member to review, manage, and update the administrative account via a web browser, the administrative account comprising a history of health plans including

past and present health plans of the at least one member and their dependents; and  
"wherein the administrative account is owned by the at least one member"

However, these features are known in the art, as evidenced by Joao. In particular, Joao suggests a computer system for use in a web-based managed care transaction system,(See Joao, Fig.1; Col.13, lines 18-42; Col.15, lines 52-67) "wherein the web-based managed care transaction system is adapted to enable via the linked set of data tables, an administrative account to be moved across health plans of the at least one member and their dependents throughout their life (See Joao, Col.5, lines 41-48);

wherein the web-based managed care transaction system is adapted to allow the at least one member to review, manage, and update the administrative account via a web browser, the administrative account comprising a history of health plans including past and present health plans of the at least one member and their dependents; and  
"wherein the administrative account is owned by the at least one member" (See Joao, Col.5, lines 41-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Joao within the teachings of Warady with the motivation of providing an apparatus and a method for allowing an employee or benefits administrator to communicate with, and transact benefits-related business with, the respective employer and/or with any of the various benefits providers (See Joao, Col.2, lines 44-48).

As per claim 2, Warady discloses the computer system wherein the set of data tables includes an employer table having associated therewith a set of one or more employer plan tables (See Warady, Col.5, lines 1-54).

As per claim 3, Warady discloses the computer system wherein a given employer plan table identifies a given employer plan (See Warady Col.5, lines 1-54).

As per claim 4, Warady discloses the computer system further including a managed care organization (MCO) table having associated therewith a set of one or more MCO product plan tables (See Warady Col.4, lines 15-20).

As per claim 5, Warady discloses the computer system wherein a given MCO product plan table has associated therewith the set of one or more employer plan tables (Col.5, lines 1-54).

As per claim 6, Warady discloses the computer system wherein a given member history table has associated therewith a set of one or more coordinated benefits tables (Col.5, lines 1-39).

As per claim 7, Warady discloses the computer system wherein a given member history table has associated therewith a set of one or more assigned primary care physician (PCP) tables (Col.5, lines 1-54).

As per claim 8, Warady discloses the computer system wherein an assigned PCP table has associated therewith a provider affiliation table (Col.5, lines 1-54).

As per claim 9, Warady discloses the database wherein the set of data tables further includes a provider information table (Col.5, lines 1-54).

As per claim 10, Warady discloses the computer system wherein the provider information table includes a set of one or more provider affiliation tables, a set of one or more hospital affiliation tables, and a set of one or more provider staff tables (Col.5, lines 1-54).

As per claim 11, Warady discloses the computer system wherein the set of data tables includes a staging area table that includes data which tracks the member through various transaction events (Col.5, lines 42-67 to Col.6, line 11).

As per claim 12, Warady discloses a database for storing a set of linked data tables organized into a persistent logical entity wherein said logical entity maintains data on each member in spite of status changes and including for each member (See Warady, Fig.2; Col.5, lines 5-42): a master account table including account setup information for at least one of utilization and login actions for said web-based managed care transaction system, a member table including identity information for at least one

member and their dependents (See Warady; Col.9, lines 24-58); a set of one or more member history tables associated with the member table, each member history table associated with a given employer plan (See Warady Col.5, lines 6-54).

Warady does not explicitly disclose a web-based managed care transaction system accessible over a computer network using a client browser, comprising a transaction server; "wherein the web-based managed care transaction system is adapted to enable, via the linked set of data tables an administrative account to be moved across health plans of the at least one member and their dependents throughout their life;

wherein the web-based managed care transaction system is adapted to allow the at least one member to review, manage and update the administrative account via the client browser, the administrative account comprising a history of health plans including past and present health plans of the at least one member and their dependents; and "wherein the administrative account is owned by the at least one member" .

However, Joao suggests a web-based managed care transaction system accessible over a computer network using a client browser,(See Joao, Fig.1; Col.13, lines 18-42; Col.15, lines 52-67), comprising a transaction server; "wherein the web-based managed care transaction system is adapted to enable, via the linked set of data tables an administrative account to be moved across health plans of the at least one member and their dependents throughout their life (See Joao, Col.5, lines 41-48);

wherein the web-based managed care transaction system is adapted to allow the at least one member to review, manage and update the administrative account via the



client browser, the administrative account comprising a history of health plans including past and present health plans of the at least one member and their dependents; and “wherein the administrative account is owned by the at least one member” (See Joao, Col.5, lines 41-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Joao within the teachings of Warady with the motivation of providing an apparatus and a method for allowing an employee or benefits administrator to communicate with, and transact benefits-related business with, the respective employer and/or with any of the various benefits providers (See Joao, Col.2, lines 44-48).

As per claim 13, Warady discloses at least one client machine on which a graphical user interface operates (See Warady; Col.13, lines 23-54), a network-based subsystem comprising: a multiplexer (The Examiner interprets interfaces 702,704 and 706 to be a form of multiplexer Col.9, lines 17-60); a plurality of functional modules (See Warady, Fig.1; Col.4, lines 21-67), a transaction processor (See Warady, Col.13, lines 23-28), a managed care organization (MCO) subsystem interfaced to said transaction processor (See Warady, Col.4, lines 12-39), a database wherein a logical entity retains data representative of users received healthcare within said database persistent across changes to a user's healthcare plan (See Warady, Col.4, lines 1-67 to Col.5, line 64), said database including a master account table for retaining account setup information for at least one of utilization and login actions for said web-based managed transaction

system, and a member table including identity information for at least one member and their dependents (See Warady, Col.4, lines 1-67 to Col.5, line 64).

Sullivan does not explicitly disclose a network-based managed care system comprising a network based server; "wherein the network web-based managed care transaction system is adapted to enable, via the database, an administrative account to be moved across health plans of the at least one member and their dependents throughout their life; and wherein the administrative account comprises a history of health plans including past and present health plans of the at least one member and their dependents; and wherein the administrative account is owned by the at least one member".

However, Joao suggests a network-based managed care system comprising a network based server; "wherein the network web-based managed care transaction system is adapted to enable, via the database, an administrative account to be moved across health plans of the at least one member and their dependents throughout their life (See Joao, Col.5, lines 41-48); and wherein the administrative account comprises a history of health plans including past and present health plans of the at least one member and their dependents; and wherein the administrative account is owned by the at least one member" (See Joao, Col.5, lines 41-48).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Joao within the teachings of Warady with the motivation of providing an apparatus and a method for allowing an employee or benefits administrator to communicate with, and transact benefits-related business with, the

respective employer and/or with any of the various benefits providers (See Joao, Col.2, lines 44-48).

As per claim 14, Warady discloses the network-based managed care system wherein said functional modules comprise: an enrollment module (See Warady, Fig.1; Fig.5) billing module (Fig.5), messaging module (Fig.5); and inquiry module (Fig.5).

As per claim 15, Warady discloses the network-based managed care system wherein changes to a user's health plan occur as a user changes employment (See Warady, Col.4, lines 1-67 to Col.5, line 64).

As per claim 16, Warady discloses the network-based managed care system wherein changes to a user's health plan occur as a user changes their healthcare plan (See Warady, Col.4, lines 1-67 to Col.5, line 64).

As per claim 17, Joao discloses the network-based managed care system wherein the network comprises an Internet (See Joao, Col.15, lines 52-57).

As per claim 18, Warady discloses the network-based managed care system wherein said the database contains a historical record of care provided to said user (Co1.10, lines 42-67).

As per claim 19, Warady discloses the network-based managed care system wherein said persistent logical entity comprises the administrative account (Col.4, lines 1-20).

As per claim 20, Warady discloses the network-based managed care system wherein said persistent logical entity spans a user's change in employment plans (Col. 5, lines 65-67 to Col.6, line 53).

### ***Response to Arguments***

5. Applicant's arguments filed on 08/01/08 with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments will be addressed in the order in which they appear in the response filed on 08/01/08.

(A) At pages 1-4 of the 08/01/08 response, Applicant argues that the features in the 08/01/08 amendment are not taught by or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 01/09/08 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Warady and/or Joao based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the Office Action, and incorporated herein. One cannot show nonobviousness by attacking references

individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference, nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied art teaches method and apparatus for benefit and financial communication (4,648,037) and method and apparatus for informing wireless clients about updated information (6,654,786)..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/

Examiner, Art Unit 3687

October 14, 2008